

REMARKS

Claims 1-39 were pending, with Claims 1, 13 and 19 being independent. Claims 8, 12-18 and 21-39 have been cancelled. Claims 1 and 19 have been amended.

Claims 1-7, 9-11 and 19-20 remain in prosecution.

Double Patenting Rejections:

Claims 13 and 14 stand rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as Claims 1 and 2 of prior U.S. Patent No. 6,672,378 for the reasons given at page 2 of the Action.

Applicant's cancellation of Claims 13 and 14 obviate the Section 101 rejections thereof.

Claims 7 and 38 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claim 1 of U.S. Patent No. 6,672,378 for the reasons given at pages 2-4 of the Action.

In an effort to advance prosecution on the merits but without conceding the propriety of the bases for the latter double patenting rejection, Applicant is prepared to submit a Terminal Disclaimer to remove the '378 patent from the obviousness-type double patenting rejection set forth above.

Accordingly, upon submission of such terminal disclaimer the obviousness-type double patenting rejection should no longer be maintained and withdrawal thereof is respectfully requested. Applicant respectfully requests express acknowledgement by the Examiner in the next written communication that such submission would remove the obviousness-type double patenting rejection.

Section 112 Rejections:

Claims 13 and 14 stand rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite for reasons given at page 2 of the Action.

Applicant's cancellation of Claims 13 and 14 obviate the Section 112, second paragraph, rejections thereof.

Claims 37-39 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement for reasons given at pages 4-5 of the Action.

Applicant's cancellation of these claims obviates the Section 112, first paragraph, rejections thereof.

Applicant has amended Claims 1 and 19 and the specification at [0031] to reflect the claimed range introduced therein. The specification amendments are found in U.S. Patent No. 6,652,705, which is expressly incorporated by reference, at

column 5, lines 60-64. Thus, the specification amendments do not constitute new matter. And the rejection of Claims 37 and 39, the substance of which now appear in independent Claims 1 and 19, respectively, should not be applied against Claims 1 and 19.

Applicant requests that the Section 112 rejections be withdrawn.

Section 102 Rejections:

Claims 1, 4, 9-11 and 19 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,660,917 (Fujimori) for reasons given at pages 5-6 of the Action.

Claims 2, 3, 5, 6 and 20 stand rejected under 35 U.S.C. § 102(a) as allegedly being unpatentable over Fujimori for reasons given at page 6 of the Action.

Applicant traverses these Section 102 rejections.

As the Examiner is aware, the invention as defined for instance by Claim 1 is directed to and claims a thermal interface wafer for facilitating heat transfer from an electronic component to a heat sink when interposed therebetween, the wafer comprising at least one linear substrate having first and second surfaces with edges, the substrate having at least one layer of conformable, heat-conductive

material formed upon a respective surface thereof, the heat-conductive material being formulated to enhance the heat transfer from the electronic component to the heat sink, where the wafer is formed from a cross-section having a shape selected from the group consisting of generally rectangular, generally circular, and generally square and the substrate is disposed to assume a substantially perpendicular orientation relative to the electronic component whereby the edges of the substrate contact the electronic component and the heat sink. The heat-conductive material melts at a temperature from between approximately 50°C and 61°C.

Fujimori is directed to and claims a thermal conductivity sheet in which a plurality of thermally conductive insulators, each having two end faces, are continuously interconnected through a flexible matrix insulator, where only a portion of the thermally conductive insulators are arranged obliquely in the direction of thickness of the thermal conductivity sheet such that at least one end face of each of the thermally conductive insulators in the portion of insulators arranged obliquely is exposed to a surface of the matrix insulator.

As at least the recitation that heat-conductive material melts at a temperature from between approximately 50°C to 61°C is not disclosed, taught or suggested by Fujimori, the

Section 102 rejections of Claims 1 and 19 should no longer be maintained, and those claims should be determined to be allowable.

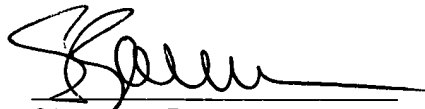
As the remaining claims in prosecution depend, directly or indirectly, from one or the other of Claims 1 or 19, they too are deserving of a determination that they are allowable.

CONCLUSION

In view of the above, favorable reconsideration and passage to issue of the present case are respectfully requested.

Applicant's undersigned attorney may be reached at telephone (860) 571-5001 or by facsimile at (860) 571-5028. All correspondence should be directed to the address given below.

Respectfully submitted,



Steven Bauman
Attorney for Applicant
Registration No. 33,832

Henkel Corporation
Legal Department
1001 Trout Brook Crossing
Rocky Hill, CT 06067